REMARKS/ARGUMENTS

An RCE has been filed herewith. Entry and consideration of the above amendment is respectfully requested.

Support for the amendment to Claim 1 is found in Examples 7-12 summarized in Table 3-2 at specification page 29, at specification page 8, line 19 - page 9, line 20 and at specification page 21, lines 6-8. No new matter has been entered.

The rejection of the claims over Japan 2002-147477 (Denpo) in view of Bialas and Papay is traversed.

It is noted that in addition to Denpo, Bialas and Papay the Examiner also relies on disclosures in Egawa and Baba. See page 3, bottom, of the Official Action. Thus, the rejection is actually a five-reference obviousness rejection over Denpo, Bialas, Papay, Egawa and Baba.

Denpo admittedly lacks Applicants' claimed monoether compound represented by formula (II), Applicants' non-metallic antistatic agent (B) which is a condensate product from a polyethyleneimine and a fatty acid, and Applicants' friction modifier (C) which is an amine salt of a phosphate ester. See the paragraph bridging pages 2-3 of the outstanding Official Action. Frankly speaking, what Denpo and the present invention have in common has not yet occurred to Applicants.

As if this wasn't enough, the Office has taken the position that becasue Denpo is not particularly interested in the lubricating oil used in Denpo's compositions the reference somehow "implicitly discloses" the presently claimed kinematic viscosity of 25 mm^2/s or less at 40°C, viscosity index of 100 or higher, flash point of 150°C or higher, and pour point of -40°C or lower, of Applicants' claimed composition.

Clearly, Denpo is not a reference related to or descriptive of the presently claimed subject matter, and the fact that the Office nowhere provides any basis whatsoever for the

wholly unsupported allegation that Denpo "implicitly discloses" the presently claimed kinematic viscosity, etc. of Applicants' presently claimed composition makes it clear that the rejection as a whole is faulty, as no other reference is alleged to provide such teachings.

Thus, and even if one were to accept the statements and reasoning of the Office with regard to Bialas, Papay, Egawa and Baba (which Applicant does not) one would still be left with no teaching of the physical characteristics of the presently claimed inventive conductive lubricant composition (kinematic viscosity, viscosity index, flash point, and pour point) that provide the electricity-saving effects (specification page 5, lines 15-18), viscosity stability with respect to temperature change (specification page 5, lines 23-24), and lifetime (specification page 6, lines 2-4) demonstrated herein. As such, even the combination of Denpo, Bialas, Papay, Egawa and Baba cannot and do not teach each and every limitation of the present claims, and thus fail to provide a *prima facie* case of obviousness. The rejection should be reconsidered and withdrawn.

In addition, and as noted previously, Applicants have shown that the presently claimed conductive lubricant composition provides several excellent functional properties that are nowhere disclosed or suggested by the prior art, including excellent volume resistivity. See for example present Examples 9, 11 and 12 in Table 3-2 at specification page 29 and compare these Examples with the presently amended claims in regard to component ranges.

As these results show, excellent volume resistivity values when friction modifier A, an amine salt of a phosphate ester, (see Table 2 at specification page 27) is used:

TABLE 3-2

Lubricant composition (parts by mass)	Ex. 7	Ex. 8	Ex. 9	Ex. 10	Ex. 11	Ex. 12
Base oil A-1						
Base oil A-2	68.8	68.8	97.75		67.7	67.75
Base oil A-3						
Base oil B	30			98.75	30	
Base oil C						
Base oil D		30				30
Base oil E						
Anti-oxidant	1	1	1	1	1	1
Rust preventive			1		1	1
Friction modifier A			0.05		0.05	0.05
Friction modifier B				0.05	0.05	
Antistatic agent A						
Antistatic agent B						
Antistatic agent C	0.2	0.2	0.2	0.2	0.2	0.2
(Total)	100	100	100	100	100	100
Kinematic viscosity (mm^2/s) at 40° C.	8.58	8.71	8.851	9.009	8.49	8.95
Viscosity index	131	112	123	132	131	112
Flash point (COC method) (° C.)	214	205	204	210	211	204
Pour point (° C.)	−45	−45	−50	−40	−45	−45
Volume resistivity ($\times 10^{10}\ \Omega \cdot cm$)	0.15	0.27	0.0135	0.36	0.0122	0.014
Thin film residue test (80° C., 500 hr)						
Percent oil retention (mass %)	95.2	91.44	94.97	94.06	94.83	91.27
Appearance (sludge)	No	No	No	No	No	No

These results are commensurate in scope with the presently amended claims and provide volume resistivity values that are substantially lower than that obtained even with a composition closer to the presently claimed invention than anything disclosed or suggested by the prior art – compare Example 10, using a polysulfide friction modifier, with Examples 9, 11 and 12, using the presently claimed amine salt of a phosphate ester friction modifier. As nothing in even the combination of references applied herein discloses or suggests such a beneficial effect, these results clearly are unexpected vis-à-vis the applied references, commensurate in scope with the pending claims, and further supportive of patentability herein, particularly in view of the substantial amendments to Claim 1 above.

Accordingly, and in view of the lack of a *prima facie* case of obviousness herein, and in view of the surprisingly beneficial results obtained with Applicants' narrowly claimed

conductive lubricant composition, Applicants respectfully request the reconsideration and withdrawal of the outstanding rejections, and the passage of this case to Issue.

Respectfully submitted,

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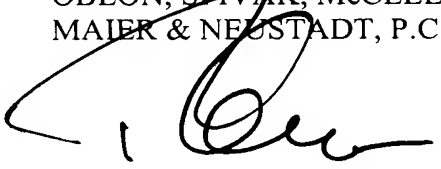

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